

REMARKS

Continued prosecution and reconsideration of the above-identified application is respectfully requested in view of the amendments above and the discussion that follows.

Claims 9, 10 and 11 have been amended.

Claim 13 has been re-presented as a new claim but is original Claim 8 deleted in amendment paper dated 3/6/2003.

Claims 1-7 and 9-13 are in the case and are before the Examiner.

I. Information Disclosure Statement

Applicants resubmit copies of references cited in the specification and attach a copy of the previously submitted 1449 Form. Applicants have confirmed that the ink of the copies should not smear. Applicants request that these references be made of record and cited in the pending application.

II. The Amendments

As stated by the Examiner, the indicated allowability of Claims 9 and 12 is withdrawn. Because the indicated allowability of Claims 9 and 12 is withdrawn and Applicant had previously amended Claims 9 and 12 to further prosecution to the indicated allowability as specifically suggested by the Examiner in office action dated 11/6/2002, Applicant adds Claim 13 (reinstated-previously Claim 8) in response to the new/different grounds of rejection. Claims 9, 10, and 11 are amended to depend upon Claim 13.

III. Claim Rejections – 35 USC § 103

Claims 9-12 have been rejected under 35 USC § 103(a) as being unpatentable over Tellado, et al. (U.S. Patent No. 6,424,681) in view of Derks, et al. (U.S. Patent No. 6,021,119). After a careful review of Tellado, Derks and the claims, it is believed that the rejections are in error and the rejections are, therefore, traversed.

First, MPEP § 2141.01(a) requires that for an Examiner “to rely on a reference under 35 USC § 103, it must be analogous prior art.” The Examiner must determine what is “analogous prior art” for the purpose of analyzing the obviousness of the subject matter at issue. See for example, Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858 (Fed. Cir. 1993) (Reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories. Furthermore, since memory modules of the claims at issue were intended for personal computers and used dynamic random-access-memories, whereas reference SIMM was developed for use in large industrial machine controllers and only taught the use of static random-access-memories or read-only-memories, the finding that the reference was nonanalogous was supported by substantial evidence.). MPEP § 2141.01(a) - Analogy in the Electrical Arts, pg. 2100-117.

The Examiner has relied on Derks in rejecting Claims 9-12. Derks however, is not “analogous prior art” for the purpose of analyzing the obviousness of the subject matter at issue. Derks pertains to an “interactive response system” and is drawn to obtaining individual responses of audience members whereby a central location retrieves responses from a plurality of users. Derks, title; summary of the invention; col. 4, lines 24-67; claims. In contrast, applicants’ invention is drawn to a “multicarrier

communication system" and is exemplified by Fig. 1 of the application. Title; Specification, pg. 1; Fig. 1. "A typical multicarrier transmission system is depicted in Figure 1. It shows serial data in the form of bits input to a serial to parallel converter 100, which also frames the bits.... The output bit frame is mapped to symbols in the mapper 300. The frame of symbols then passes through the modulator 400.... The modulated signal is converted to serial data (block 700) and transmitted on to the channel 900...."

Specification, pg. 1. As is known to a person of ordinary skill in the art, the term "multicarrier communication system" has specific meaning. As such, the term is used extensively in prior art reference Tellado. Tellado, abstract; background; summary of the invention; claims. Specifically, Tellado defines that a multi-carrier system is composed of "a number of independent signals" where "each signal is centered" at a different frequency" and the frequencies are commonly referred to as "carrier frequencies."

Tellado, col. 1, lines 17-22. In contrast, nowhere in Derks is there a mention of a "multicarrier communication system" nor is the general term "carrier" present in the Derks patent. As is known to a person of ordinary skill in the art, the "interactive response system" technology of Derks is irrelevant to the "multicarrier communication system" technology of the present application. Because Derks is not concerned with "multicarrier communication system" technology and is drawn to "interactive response system," technology, Derks is not "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. Since Derks is not "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue, the rejection under 35 USC § 103(a) is improper and should be withdrawn.

Not notwithstanding that Derks is not “analogous prior art,” MPEP § 2141.02 requires that the claimed invention as a whole be considered. Section 2141.02 provides that “in determining the differences between the prior art and the claims, the question under 35 USC § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 (Fed. Cir. 1983).” [emphasis in original] “It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of the other parts necessary to the full appreciation of what such references fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 USPQ 391 (CCPA 1965). The Examiner states that the difference between applicants’ invention and the prior art is that prior art reference Tellado “possibly does not disclose that the threshold is selectable and the correction value is selectable” and Derks¹ “discloses having selectable thresholds for a system.” Office Action, pg. 3. The Examiner states that this difference (i.e. selectable threshold and selectable correction value) would have been obvious to one of ordinary skill in the art. Specifically, the Examiner states that “it would have been obvious to one of ordinary skill in the art to have the threshold and the correction value be selectable in order to allow the system user to tailor the system to the user’s preferences. Office Action, pg. 3. However, MPEP § 2141.02’s requirement is not whether the difference is obvious, but whether applicants’ invention as a whole is obvious and applicants’ invention as a whole is not that “the threshold and the correction value be selectable in order to allow the system user to tailor the system to the user’s preferences.” For the

¹ Even though Derks is not “analogous prior art,” the subsequent remarks address the improper

Examiner to have considered the applicants' invention as a whole, he would have had to find obvious "the predetermined threshold being selectable to control the number of samples violating the threshold" in the context of the other elements of the claimed invention. Claims 9-12, 13; Office Action, pg. 3. Since the Examiner did not consider the claimed invention as a whole, the rejection under 35 USC § 103 is improper and should be withdrawn.

Not notwithstanding the previous arguments, MPEP § 2143.01 requires that the prior art must suggest the desirability of the claimed invention. Section 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680 (Fed. Cir. 1990)." As mentioned above, Tellado is concerned with a "multicarrier communication systems" and Derks pertains to an "interactive response system." Tellado, abstract; summary of the invention; Derks, title; summary of the invention; col. 4, lines 24-67; claims. In neither Tellado nor in Derks is there any teaching, suggestion or motivation to combine a "multicarrier communication system" with an "interactive response system." Applicants' understand the Examiner to represent that there is desirability of combining the "multicarrier communication system" of Tellado with some teaching of selectable thresholds; but absent a teaching, suggestion or motivation in the prior art references themselves, the combination of Tellado with Derks is improper. Since the combination of Tellado with Derks is improper, the rejection under 35 USC § 103 is improper and should be withdrawn.

combination of Tellado with Derks.

Finally, it would not be an obvious matter for one skilled in the art to reconstruct Tellado and Derks to achieve applicants' invention as recited in applicants' claims without the benefit of hindsight of applicants' disclosure and such is clearly improper. As numerous Federal Circuit cases have admonished, the Examiner must be ever alert not to read obviousness into an application on the basis of applicants' own statements and must further view the prior art without reading into that art applicants' teachings. In re Sponnoble, 405 F.2d 578 (CCPA 1969). It is not enough for a valid rejection of the patent application to view the prior art in retrospect; once applicants' disclosure is known, the prior art should be viewed by itself to see if it fairly discloses what the applicants have done. In re Schaffer, 220 F.2d 476 (CCPA 1956). "A piece meal reconstruction of prior art patents in light of appellant's disclosure shall not be a basis for obviousness." In re Kamm & Young, 172 USPQ 298 (CCPA 1972). Because the Examiner has used the teachings of the present application as a road map to combine Tellado with Derks, the combination of Tellado with Derks is improper. Thus, the rejection under 35 USC § 103 is improper and should be withdrawn.

For all of the above reasons, the rejection of Claims 9-12 is believed to be improper and should be withdrawn. Applicants have added Claim 13 (reinstated-formerly Claim 8) which is also allowable for all the same reasons.

IV. Allowable Subject Matter

Examiner states that Claims 1-7 are allowable. Therefore, the allowance of Claims 1-7 believed to be in order and such action is earnestly solicited.

SUMMARY

The allowance of Claims 1-7, 9-13 is believed to be in order and such action is earnestly solicited. The application is believed to be in condition for allowance. An early notice to that effect is earnestly solicited. The Examiner is requested to phone the undersigned should any questions arise that can be dealt with over the phone and expedite this prosecution.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this Reply and Amendment is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231 on July 28, 2003.

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